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APR 9 1992

UNITED STATES PATENT AND TRADEMARK OFFICE
 BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re)	Decision on Petition
)	under 37 CFR § 10.2(c)
_____)	

(petitioner) requests review under 37 CFR § 10.2(c) of a decision of the Director of Enrollment and Discipline, entered February 26, 1992, refusing to give petitioner a passing grade on the afternoon section of the examination for registration held on August 21, 1991.

BACKGROUND

The Director's decision was on a request, under 37 CFR § 10.7(c), for regrade of Part I, Option A of the afternoon section. Petitioner scored 64 points on the afternoon section. The decision on request for regrade added no points.

Petitioner challenges the Director's decision on three grounds:

(1) He should not have been penalized twice for failure to include a petition for extension of time, i.e., he should have been penalized either ten points for failure to include a petition for extension of time, or five or six points for using a petition to revive, but not sixteen points for both mistakes.

(2) He should not have been penalized one point for not recopying a caption incorporated by reference.

(3) He should not have been penalized eight points for failing to include a particular limitation in an independent claim.

A minimum of six more points, however, would be sufficient to give petitioner a passing grade of 70 (out of 100).

FACTUAL REVIEW

Part I, worth 52 points, was drawn to drafting a response to an Office action. Part I presented three options -- A, B or C. Petitioner chose Option A. Part I, Option A presents the following relevant facts:

You (i.e., the applicant for registration) are a registered practitioner. Today, on August 21, 1991, Cool Dude consults you, and asks you to represent him in prosecuting a patent application he had prepared and filed in the PTO. The application contains three claims -- claims 1-3. On March 21, 1991, an examiner mailed a first Office action to Dude rejecting claims in Dude's application, setting a three month shortened statutory period for response. Dude provides you with a copy of the application he filed and the first Office action. You agree to represent Dude.

Dude's invention is an illuminated brush device. The object of Dude's invention is disclosed as providing a brush device having plastic fiber optic filaments which act as bristles and which transmit light having greater light intensity than the original light source to the tips of the bristles to illuminate the area in close proximity to the bristles. The device is disclosed as also

containing a light producing means and a magnification means coupled to the fiber optic filaments. When the light producing means is energized, light is transmitted through the magnification means and a plurality of plastic filaments so that light emanates from the filaments forming the bristles.

It is disclosed further that the magnification means is "essential" to the operation of the brush device because of the necessity to concentrate and intensify the light into the optic fiber filaments to intensify the light emitted from the tips of the bristles.

Dude instructs you to prepare and file a response to the Office action. He tells you that he is of modest means and cannot afford to pay more than a minimal amount for services and costs to respond to the Office action. Dude clearly instructs you that you must not incur any costs which can be avoided pursuant to PTO rules. It is your firm's strict policy never to advance any government fees for any client for any reason. Dude gives you a check to cover your legal fees and for a two month extension of time.

The instructions to Part I, Option A require the preparation of a timely and complete response to the Office action under 37 CFR § 1.111 which does not cause the firm or Dude to incur further costs or fees. For purposes of the

examination, the response must cancel claims 1-3 and present a new single independent claim which, inter alia, defines the novelty of the invention as set forth in the object of the invention.

Petitioner drafted a response to the Office action. The response included an amendment cancelling the existing claims and adding one independent claim and one dependent claim. The independent claim did not recite the magnification means, for which eight points were deducted. The dependent claim limited the independent claim by reciting the magnification means.

Petitioner did not include a petition for an extension of time, for which ten points were deducted. Instead, petitioner included a petition to revive. Five points were deducted because of improper procedure, since the application was not abandoned. One additional point was deducted because the petition to revive did not have a proper heading but instead, incorporated by reference the same heading used for the amendment.

DECISION

I find no error in the deduction of points both for not including a petition for extension of time and for including a petition to revive.

Petitioner's argument that a "double penalty" was imposed by deducting points both for the absence of a petition for extension of time and the presence of a petition to revive is not well-taken. Ten points were uniformly deducted for failure

to include a petition for a two-month extension of time. In this case, as shown below, it was not improper to deduct five additional points for including a petition to revive.

The facts specifically state Dude's instructions that he cannot afford to pay more than a minimal amount for services and costs to respond to the Office action and that you must not incur any costs which can be avoided pursuant to PTO rules. The facts further state that it is your firm's strict policy never to advance any government fees for any client for any reason. Your filing of a petition to revive, besides indicating that you did not appreciate that the application was not abandoned, ignored both Dude's instructions and your firm's strict policy. You incurred a cost which could have been avoided pursuant to PTO rules and you advanced a government fee for a client.

Since the petition to revive, for which five points were deducted, was a document which should never have been filed, it was inappropriate to deduct another point for petitioner's incorporation by reference of a proper heading thereon. Therefore, one point will be added to petitioner's grade.

I find no error in deducting eight points for failure to recite the magnification means in the independent claim. Petitioner's argument that the magnification means was not required to overcome the prior art is true. But the argument that therefore it was not required to be included in the broad claim of the application does not, in this case, follow.

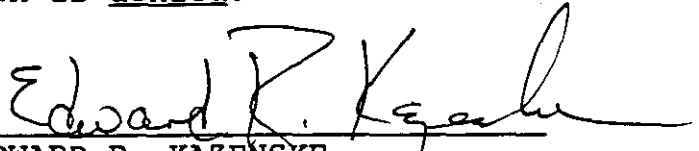
The magnification means is disclosed as essential to the operation of the brush device. Without it, the object of the invention is not realized, i.e., the light is not concentrated and intensified into the optic fiber filaments to intensify the light emitted from the tips of the bristles. Contrary to petitioner's argument, the magnification means is not merely a preferred embodiment but an essential element. The instructions require the presentation of a new single independent claim which, inter alia, defines the novelty of the invention as set forth in the object of the invention. Petitioner's independent claim does not accomplish this end.

Petitioner's independent claim would be subject to a rejection under 35 U.S.C. 101 and/or 35 U.S.C. 112 on grounds that the claimed invention would be inoperative for the intended purpose disclosed in the specification. Such a rejection would cause Dude to incur further costs or fees, if he wished to further pursue obtaining a patent, contrary to the instruction that a response be prepared which does not cause the firm or your client to incur further costs or fees.

CONCLUSION

One point has been added to petitioner's grade of 64, for a total of 65. Since petitioner has not achieved a passing

grade, the Director's decision of February 26, 1992 is affirmed. Therefore, this petition is denied.


EDWARD R. KAZENSKE
Director of Interdisciplinary
Programs